



UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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AUG - 4 2003

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In re application of :
Jay M. Short :
Serial No. : 09/089,789 : DECISION ON PETITION
Filed : June 3, 1998 :
Attorney Docket No.: DIVER1270-3 :

This is in response to applicants' petition under 37 CFR 1.181, filed April 22, 2003, requesting withdrawal of the holding of abandonment based on non-receipt of an Office action.

A review of the file history shows that the examiner mailed an Office action (final rejection) to applicant on May 9, 2002, setting a three month shortened statutory time period for reply. On February 3, 2003, the Office mailed a Notice of Abandonment to applicant indicating that no response to the final rejection had been received.

37 CFR 1.181(f) states, in part:

Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Since applicant did not respond to the Notice of Abandonment until more than 2 months had elapsed, the instant petition is deemed untimely.

MPEP 711.03(c)(I) states, in part:

The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years

from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c).

Since the instant petition was not accompanied by the required terminal disclaimer, it has not been treated on its merits.

Applicant's representative states that she was in contact with the examiner within the 2 month period after the Notice of Abandonment was mailed, and that the examiner was attempting to provide a copy of the final rejection. The relevance of this information is not clear. The examiner is not authorized to withdraw the holding of abandonment, nor would providing a copy of the outstanding Office action serve to change the status of the application.

Applicant's petition is **DISMISSED** without prejudice to reconsideration.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll
Director, Technology Center 1600